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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/803,044	03/12/2001	Rabah Boukherroub	10963-US	8419
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EXAMINER

CEPERLEY, MARY

ART UNIT	PAPER NUMBER
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1641

DATE MAILED: 09/20/2002

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/803,044

Applicant(s)

BOUKHERROUB ET AL.

Examin r

Mary (Molly) E. Ceperley

Art Unit

1641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____ .
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-35 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ .
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____ .
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

Art Unit: 1641

1) Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-8, 11-18, 21-28, 30, 32, and 34 (at least part of each), drawn to a method of stabilizing a porous silicon using a $\text{RCH}=\text{O}$ or $\text{RCH}=\text{S}$ (aldehyde or thioaldehyde) reactant.
- II. Claims 1-35 (at least part of each), drawn to a method of stabilizing a porous silicon using a $\text{RCH}=\text{CH}_2$ (alkenyl) reactant.
- III. Claims 1, 3-5, 12-18, 21-26, 28, 30, 32, and 34 (at least part of each), drawn to a method of stabilizing a porous silicon using a $\text{RCH}=\text{NR}'$ reactant.
- IV. Claims 1, 3-5, 12-18, 21-26, 28, 30, 32, and 34 (at least part of each), drawn to a method of stabilizing a porous silicon using a R-OH or -RSH (hydroxy or thiol) reactant.
- V. Claims 1, 3-5, 12-18, 21-26, 28, 30, 32, and 34 (at least part of each), drawn to a method of stabilizing a porous silicon using a $\text{R-NHR}'$ (amine) reactant.

2) The inventions are distinct, each from the other because:

Each of Inventions I-V is unrelated to any other invention. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are directed to patentably distinct methods which use reactants which contain different chemical functional groups which react by different mechanisms to produce different types of products. See the "Background of the Invention" section of the instant specification which describes methods which use diverse types of reactants to attach moieties to a silicon surface. A reference which might anticipate the reaction of an aldehyde with an Si-H group would not necessarily render obvious the reaction of an Si-H group with a $\text{RCH}=\text{NR}'$ group.

Art Unit: 1641

3) Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter requiring divergent fields of search in both the patent and technical literature and different patentability considerations, restriction for examination purposes as indicated is proper.

4) Applicants are advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5) Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary E. (Molly) Ceperley whose telephone number is (703) 308-4239. The examiner can normally be reached from 8 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le, can be reached at (703) 305-3399. The fax phone number for responses to be filed BEFORE final rejection is (703) 872-9306. The fax phone number for responses to be filed AFTER final rejection is (703) 872-9307.

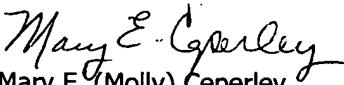
Questions which are NOT RELATED TO THE EXAMINATION ON THE MERITS, should be directed to **TC 1600 CUSTOMER SERVICE** at **(703) 308-0198**. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Application/Control Number: 09/803,044

Page 4

Art Unit: 1641

September 19, 2002


Mary E. (Molly) Ceperley
Primary Examiner
Art Unit 1641